

In re Patent Application of  
**Gary L. Martin**  
Serial No. 09/801,512  
Filed March 7, 2001

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#### REMARKS

Applicant files this response within one month of the final Office action and respectfully requests the Examiner's reconsideration. Applicant gratefully acknowledges the Examiner's withdrawal of the previous claim rejections based on lack of novelty, accordingly, the remaining concerns are limited to issues of obviousness.

#### Applicant Requests Withdrawal Of The Finality Of The Pending Office Action

The pending application is a Request for Continued Examination (RCE). The pending action is a final rejection on first action and Applicant respectfully suggests is improper under MPEP §706.07(b). The primary reference cited in support of the obviousness rejection in the final action is **Chambers (US 5,605,020)**, which **was not of record** in the previous application. The references by Chalmers et al. (US 4,195,455), Meckstroth (US 5,459,965), and Hellekson (US 3,204,374) were all previously of record, but Chambers was not.

MPEP §706.07(b) requires that "all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds **and art of record** in the next Office action if they had been entered in the earlier application."

As noted above, the Chambers reference was not previously of record. Accordingly, the final rejection of the RCE on first action is premature and not proper. Therefore, Applicant respectfully requests that the Examiner withdraw the finality of the pending action.

#### The Claimed Invention is Nonobvious Over the Cited References

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The Examiner has rejected independent claims 1, 10 and 11 under Section 103(a) as obvious over the single reference to Chambers (US 5,605,020), Roofing Termination Device.

By its own description, the Chambers reference describes "a device for terminating a roofing system at the edges thereof." See column 1, lines 1-2. The Chambers invention, thus, is intended to address the problem of ensuring that the periphery of a roof is terminated in a waterproof manner. See column 1, lines 15-47. Chambers continues "[i]t is, therefore, an object of the present invention is [sic] to provide a device for terminating a roofing system at the edges of the roof by sealingly connecting the roofing system to the building on which the roofing system is deployed in such a fashion such that the fasteners utilized are situated in a waterproof manner, but are readily accessible, with the exposed vertical surface being able to withstand climatic effects." See column 1, lines 50-58. It is, therefore, clear that the Chambers invention is for a roof.

The term soffit, however, is a common word in the English language, which is defined as "the lower surface of" various architectural structures, including "the under part of an overhanging cornice, eave, etc." In turn, the term "eave" is defined as "the edge or edges of the roof of a building, which usually overhang the walls and cast off the water that falls on the roof." See attached as Exhibit 1 several pages from Webster's New Universal Unabridged Dictionary, Deluxe Second Ed., Dorset & Baber, Copyright Simon & Schuster, New York, NY, 1983. Accordingly, the soffit is the under part of the eaves, and it is also so defined in the application as filed on page 1, lines 7-25, in the section titled "Background of the Invention." Accordingly, the present invention deals with the underside of roof eaves, while the Chambers invention deals with finishing the top side of a roof at its edges. Thus, Applicant's invention addresses a completely different problem than that dealt with by the Chambers invention.

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Nevertheless, the Examiner appears to have taken the position that the Chambers invention may be turned upside down for use under the eaves of a roof, instead of being used on top of the roof, as it was intended to function. Even if this approach were feasible, however, the Chambers invention neither includes nor suggests the structure of the presently claimed invention.

As an example, please see Chambers' FIG. 2, but in an upside down orientation. Reference number 102 could indicate a side wall of a building, and reference number 110 could indicate the underside of a roof eave, that is, the soffit. The Chambers device would have a first member 12 connected to the side wall 102 by means of fastener 104, and would extend at an angle upwardly toward the soffit 110. Second member 14 is then engaged in the channel (not numbered in FIG. 2) of first member 12, and would extend outwardly toward the outer edge of the soffit, that is, toward the fascia board (not shown in this figure). Chamber's second member 14, however, does not include "a flange portion extending generally at an angle from the soffit portion of said first member", as recited in claim 1.

As a further example, please see Chambers' FIG. 3, again in an upside down orientation. If Applicant understands the Examiner's position correctly, reference number 110 could be seen as the underside of a roof eave, or the soffit, and reference numbers 114, 116 and 118 could be interpreted to be various portions of a fascia board at an outer edge of a building where the roof structure meets the soffit. In this example, member 12 could be the first member and could be said to include "a soffit portion including a proximal periphery and a generally parallel and spaced apart distal periphery extending along a lengthwise dimension of said soffit panel, and a fascia portion coextensive with the soffit portion along the distal periphery and extending generally upwardly therefrom", as recited in Applicant's claim 1. If Chambers' member 12 is equated to Applicant's first member,

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then Chambers' member 14 must be Applicant's second member, except that Chambers neither includes nor suggests that member 14 should have "a flange portion extending generally at an angle from the soffit portion of said first member", as recited in Applicant's claim 1.

A similar shortcoming by Chambers would be evident even if member 14 were to be considered Applicant's first member, and Chambers' member 12 were to be considered Applicants' second member. Presently claimed structural elements would still be missing and unsuggested by Chambers.

The same structural comparison of elements applies between Chambers and Applicant's independent claim 10. With reference to Chambers' FIG. 2 (upside down), there is no member shown which has the structure of the first member recited in claim 10, that is, "a first member having a soffit portion, and a fascia portion." Neither is this type of structure suggested by Chambers. With reference to Chambers' FIG. 3 (again, upside down), if reference number 12 is taken to be Applicant's "first member having a soffit portion, and a fascia portion", then element 14 has to be Applicant's second member, but is missing "a channel wherein a periphery of said first member is adjustably engaged to thereby connect the first member to the second member." Accordingly, the structural arrangement recited in Applicant's independent claim 10 is neither described nor suggested by Chambers.

Applicant's independent claim 11 recites a building having a soffit panel with the same structure recited in claim 1. The observations made above with regard to claim 1, therefore, equally apply to claim 11. Thus, Chambers does not describe or suggest the structure recited in independent claim 11.

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Applicant also respectfully asserts that the Office action fails to establish a *prima facie* case of obviousness against the pending independent claims. In establishing a *prima facie* case of obviousness, the Office must establish three elements:

- 1) that the combination (in this case, a single reference) produces the claimed invention;
- 2) that the prior art contains suggestion or motivation to combine the cited references in such a way as to achieve the claimed invention; and
- 3) that one skilled in the art at the time the invention was made would have reasonably expected the claimed invention to work.

As discussed above in detail, the Chambers reference does not satisfy at least elements 1) and 2) of the *prima facie* case of obviousness. Accordingly, the obviousness rejection is defective and not proper, and Applicant respectfully requests that said rejection be withdrawn.

In addition, adaptation of the Chambers invention to the purposes of Applicant's invention would require extensive structural modification of the Chambers device, and such modification would totally destroy the utility of the Chambers device for its stated purposes, which is finishing the edges of a roof in a waterproof manner. It is well settled that if use of a reference in an obviousness rejection would require such an extensive modification as to make the invention described in the reference unsuitable for its originally intended purpose, the reference may not be used in the obviousness rejection. Applicant believes such is the case with the Chambers reference.

#### **Conclusion**

For the reasons discussed above, Applicant respectfully requests withdrawal of the finality of the Office action, and withdrawal of the claim rejections for obviousness. As

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there are no currently pending independent claims which stand rejected on the grounds of lack of novelty, and in view of the remarks presented herein, Applicant submits that all pending independent claims are patentable. In addition, their respective dependent claims, which recite yet further distinguishing features, are also patentable and require no further discussion.

If the further prosecution can be facilitated through a telephone conference between the Examiner and the undersigned, the Examiner is respectfully requested to telephone the undersigned.

Respectfully submitted,



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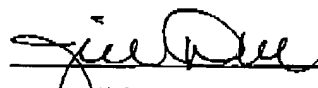
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